

the Heie reference would have been combined with the Muramatsu reference, the Henderson reference, and the Brennan reference. Applicant submits, however, that these references would not have been combined and, even if combined, the combination would not teach or suggest each and every element of the claimed invention.

None of the applied references teaches or suggests the features of the present invention, including: 1) a character string input by a user and corresponding to a voice information designating the originator of a call (claims 1 and 10); and 2) outputting a voice information corresponding to a character string registered beforehand by a user, the character string corresponding to voice information designating the originator of a call (claims 6 and 9). As explained above, these features are important for obtaining voice information by providing the instruction to the phone when an originator's information cannot be easily identified based upon the display and outputting the voice information that is easily recognizable by the user.

Indeed, the Examiner admits that the Muramatsu reference, the Henderson reference, and the Brennan reference fail to teach or suggest a character string input by a user.

However, not only do these reference fail to teach or suggest a character string input by a user, these references fail to teach or suggest a character string input by a user and corresponding to a voice information designating the originator of a call and outputting a voice information corresponding to a character string registered beforehand by a user, the character string corresponding to voice information designating the originator of a call.

The Heie reference does not remedy the deficiencies of the Muramatsu reference, the Henderson reference, and the Brennan reference.

Indeed, the Examiner fails to present a *prima facie* case of obviousness by failing to

provide (let alone allege) references which teach or suggest a character string input by a user and corresponding to a voice information designating the originator of a call and outputting a voice information corresponding to a character string registered beforehand by a user, the character string corresponding to voice information designating the originator of a call.

The Heie reference clearly does not teach or suggest a character string input by a user and corresponding to a voice information designating the originator of a call, or outputting a voice information corresponding to a character string registered beforehand by a user, the character string corresponding to voice information designating the originator of a call.

Rather, the Heie reference discloses an alternative method for inputting character strings. In particular, the Heie reference discloses a means for entering a character string in the form of “shorthand” text entry (defined term 201) and substituting a more lengthy character string in place of the “shorthand” text entry (substitute data 203).

In other words, the Heie reference merely discloses another method for character input.

The Heie reference does not remedy the deficiencies of the Muramatsu reference, the Henderson reference, and the Brennan reference by teaching or suggesting a character string input by a user that corresponds to voice information designating the originator of a call as recited by the independent claims.

Moreover, again, Applicant notes that the Examiner has very clearly failed to address the Applicants traversals regarding the complete and utter lack of any motivation to combine the references as alleged by the Examiner.

Rather, the Examiner merely regurgitates the very same allegations regarding a motivation to combine the references despite the multiple deficiencies which prevent the

Examiner from relying upon such alleged motivations.

Therefore, again, Applicant submits that the Examiner has again failed to comply with the clear requirements that are set forth in the Manual of Patent Examining Procedure. In particular, the Examiner has failed to comply with the requirements of the M.P.E.P. as set forth in § 707.07(f) by failing to answer all material traversed.

Applicant has submitted a Petition under 37 C.F.R. § 1.181 That a Complete Response Be Provided In Accordance with M.P.E.P. § 707.07(f) to address the failures by the Examiner to answer all material traversed.

Indeed, the Examiner does not mention anything at all about Applicant's traversals.

Applicant again submits that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different and unrelated matters and problems.

Specifically, the Brennan reference is directed to providing a telephone system that automatically answers a telephone so that "someone in a hands-busy situation or a handicapped individual may have calls from pre-selected callers automatically connected." (Abstract).

In stark contrast, the Muramatsu reference is specifically directed to identifying a caller using sound alone without reducing the number of available communication lines ([0011] - [0013]).

In contrast to the Brennan reference and the Muramatsu reference, the Henderson reference is directed to the completely different and unrelated problem of providing an improved call interrupt feature for a telephone answering device that permits the telephone answering device to reestablish control over the message handling function without

depending upon an elapse of time or an off-hook condition (col. 2, lines 15-21).

One of ordinary skill in the art who was concerned with providing a telephone system that automatically answers a telephone so that someone in a hands-busy situation or a handicapped individual may have calls from pre-selected callers automatically connected, as the Brennan reference is concerned with providing, would not have referred to the Muramatsu reference. That is, the Muramatsu reference is concerned with the completely different and unrelated problem of identifying a caller using sound alone without reducing the number of available communication lines.

The Examiner continues to ignore these traversals.

Further, one of ordinary skill in the art who was concerned with providing a telephone system that automatically answers a telephone so that someone in a hands-busy situation or a handicapped individual may have calls from pre-selected callers automatically connected, as the Brennan reference is concerned with providing, or who was concerned with identifying a caller using sound alone without reducing the number of available communication lines, as the Muramatsu reference is concerned, would not have referred to the Henderson reference. That is, the Henderson reference is concerned with the completely different and unrelated problem of providing an improved call interrupt feature for a telephone answering device that permits the telephone answering device to reestablish control over the message handling function without depending upon an elapsed time or an off-hook condition.

Thus, the references would not have been combined.

The Examiner also ignores this traversal.

Further, in stark contrast to the Muramatsu reference, the Henderson reference, and the Brennan reference, the Heie reference is concerned with the completely different and

unrelated problem of inputting lengthy character strings. (Col. 1, line 6 - col. 2, line 7).

One of ordinary skill in the art who was concerned with providing a telephone system that automatically answers a telephone so that someone in a hands-busy situation or a handicapped individual may have calls from pre-selected callers automatically connected, as the Brennan reference is concerned with providing, who was concerned with identifying a caller using sound alone without reducing the number of available communication lines, as the Muramatsu reference is concerned, or who was concerned with the problem of providing an improved call interrupt feature for a telephone answering device that permits the telephone answering device to reestablish control over the message handling function without depending upon an elapsed time or an off-hook condition, as the Henderson reference is concerned, would not have referred to the Heie reference because the Heie reference is concerned with the completely different and unrelated problem of inputting lengthy character strings.

Thus, the references would not have been combined.

Further, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner.

The Examiner continues to allege that it would have been obvious to modify the automatic answering system that is disclosed by the Brennan reference to “allow the user to recognize whom is calling before the phone goes off-hook.”

However, contrary to the Examiner’s allegation, one of ordinary skill in the art would not have been motivated to modify the Brennan reference to “allow the user to recognize whom is calling before the phone goes off-hook” because the answering system that is disclosed by the Brennan reference already allows “the user to recognize whom is calling

before the phone goes off-hook.”

As is clearly illustrated by the flowchart of Figure 2 of the Brennan reference, the announcement which allows “the user to recognize whom is calling” is performed in step 67, where the handsfree speaker announces the name, then in step 69 the answering system determines if the announcement is complete and, only when the announcement is complete, “the phone goes off-hook.” (Col. 3, lines 27-47).

Indeed, the Brennan reference specifically states that “a user will first hear the name of a caller announced and the call will then be connected.” (Col. 3, lines 47-50).

Therefore, since the Brennan reference already allows “the user to recognize whom is calling before the phone goes off-hook,” clearly, there is no motivation to modify the Brennan reference in order to “allow the user to recognize whom is calling before the phone goes off-hook” as alleged by the Examiner.

The Examiner continues to ignore this traversal.

Additionally, the Examiner admits that the Brennan reference does not teach or suggest outputting the voice information in response to an instruction received from a user.

The Examiner then attempts to remedy the deficiencies of the Brennan reference by referring to the Henderson reference which appears to disclose outputting caller identification data as voice data in response to a user input.

However, contrary to the Examiner’s allegation, one of ordinary skill in the art would not have modified the system that is disclosed by the Brennan reference because such a modification would destroy the intended purpose of the system that is disclosed by the Brennan reference.

Indeed, as explained previously, the Brennan reference very clearly teaches away from

making any such modification.

In stark contrast, the Brennan reference discloses an automatic answer feature for a telephone that automatically outputs a name from a speech synthesizer without requiring any instruction at all from a user during the incoming call.

In particular, the Brennan reference explains that “Upon completion of a predetermined number of ring cycles (usually only one) . . . the main controller 34 compares the decoded telephone number (or, if no telephone number, the decoded name) to the telephone numbers (or names) previously entered into the telephone directory 48 (step 64). If there is a match . . . the name in the matching record is read from the telephone directory 84 . . . [and] the main controller 34 forwards the read name to the speech synthesizer 80 (step 65) which translates the read name into a voice announcement signal which is output to the handsfree speaker.” (Col. 3, lines 3 - 31).

Thus, the automatic telephone answering system that is disclosed by the Brennan reference suffers from the same problem that is solved by the present invention.

In other words, the automatic telephone answering system that is disclosed by the Brennan reference automatically outputs the name as a voice announcement to the handsfree speaker. Therefore, the voice announcement is heard in the surroundings of the phone without the user of the telephone doing anything.

In stark contrast, the present invention avoids having the voice information automatically being heard in the surroundings by outputting the voice information in response to an instruction from the user during the incoming call.

Therefore, the Brennan reference actively teaches away from the present invention.

M.P.E.P. § 2145 X. D. 2. states:

*“It is improper to combine references where the references teach away from their combination.”* (Emphasis added).

As explained above, the present invention avoids having the voice information automatically being heard in the surroundings by outputting the voice information in response to an instruction from the user during the incoming call.

In stark contrast, the Brennan reference teaches away from outputting voice information in response to an instruction from the user during the incoming call by providing an automatic telephone answering system which automatically outputs the voice information to the surroundings because the “operation is useful where the user is handicapped, infirm, or working in a hands-busy situation.” (Col. 3, lines 48-57).

In other words, the Brennan reference teaches that the user may be “handicapped, infirm, or working in a hands-busy situation” and, therefore, may be unable to provide an instruction when receiving the incoming call in order to output the voice information into the surroundings. Therefore, the Brennan reference teaches that it is not desirable to require any instruction at all from a user before outputting the voice information into the surroundings.

Clearly, one of ordinary skill in the art would not have been motivated to modify the teachings of the Brennan reference to require that a user input be received before outputting voice information when the Brennan reference specifically teaches that it is not desirable to require any instruction at all from a user before outputting the voice information.

The Examiner completely ignores the above traversal regarding the fact that the references teach away from the Examiner’s alleged combination.

One of ordinary skill in the art at the time the invention was made would not have been motivated to combine these references to form the claimed invention.



Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 1-12, and 31-32.

**B. The Henderson reference in view of the Heie reference**

Regarding the rejection of claims 13-18 and 21-23, the Examiner alleges that the Heie reference would have been combined with the Henderson reference to form the claimed invention. Applicant submits, however, that these references would not have been combined and, even if combined, the combination would not teach or suggest each and every element of the claimed invention.

As explained previously, the Henderson reference does not teach or suggest the features of the present invention, including a memory storing a character string that was input by a user for the calling party to be retrieved for outputting voice information as recited by independent claim 13. As explained above, these features are important for obtaining voice information by providing the instruction to the phone when an originator's information cannot be easily identified based upon the display and outputting the voice information that is easily recognizable by the user.

Rather, and in stark contrast, the Henderson reference discloses a method and apparatus for an improved call interrupt feature in a cordless telephone answering device where the device may provide a speech synthesized version of caller identification data to a cordless telephone after the called party presses the "talk" button. (Col. 6, lines 1-6, and col. 6, line 64 - col. 7, line 10).

In particular, the Henderson reference discloses that the caller identification data is received from the telephone line (Figure 1, col. 6, lines 1-6) and is completely different and

unrelated to the character string that is input by a user in accordance with the invention.

Indeed, the Henderson reference only discloses that the caller identification data may be output by a speech synthesizer and does not teach or suggest outputting any data at all that may have been input by a user, let alone a character string input by a user.

The Henderson reference clearly does not teach or suggest a character string input by a user, let alone a memory storing a character string that was input by a user for the calling party to be retrieved for outputting voice information as recited by independent claim 13.

The Heie reference does not remedy the deficiencies of the Henderson reference.

The Heie reference does not teach or suggest a memory storing a character string that was input by a user for the calling party to be retrieved for outputting voice information as recited by independent claim 13.

Rather, the Heie reference discloses an alternative method for inputting character strings. In particular, the Heie reference discloses a means for entering a character string in the form of “shorthand” text entry (defined term 201) and substituting a more lengthy character string in place of the “shorthand” text entry (substitute data 203).

In other words, even assuming arguendo that the Heie reference remedies the failure of the Henderson reference to disclose “a user inputting a character string,” that disclosure does not remedy the deficiency of the applied references to teach or suggest a character string input by a user which is to be retrieved for outputting voice information as recited by independent claim 13.

Further, Applicant submits that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different and unrelated matters and problems.

Specifically, as explained before, the Henderson reference is concerned with providing an improved call interrupt feature for a telephone answering device that permits the telephone answering device to reestablish control over the message handling function without depending upon an elapse of time or an off-hook condition.

In stark contrast, the Heie reference is concerned with the completely different and unrelated problem of inputting lengthy character strings. (Col. 1, line 6 - col. 2, line 7).

One of ordinary skill in the art who was concerned with providing an improved call interrupt feature for a telephone answering device that permits the telephone answering device to reestablish control over the message handling function without depending upon an elapse of time or an off-hook condition, as the Henderson reference is concerned, would not have referred to the Heie reference and, vice-versa, because the Heie reference is directed to the completely different and unrelated problem of inputting lengthy character strings. Thus, these references would not have been combined.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 13-18 and 21-23.

**C. The Henderson reference in view of the Heie reference and further in view of the Muramatsu reference**

Regarding the rejection of claims 19-20, the Examiner alleges that the Heie reference would have been combined with the Henderson reference and further alleges that the Muramatsu reference would have been combined with the Heie reference and the Henderson reference to form the claimed invention. Applicant submits, however, that these references would not have been combined and, even if combined, the combination would not teach or

suggest each and every element of the claimed invention.

As explained above with respect to independent claim 13, from which claims 19-20 depend, the Henderson reference and the Heie reference does not teach or suggest the features of the present invention, including a memory storing a character string that was input by a user for the calling party to be retrieved for outputting voice information as recited by independent claim 13. As explained above, these features are important for obtaining voice information by providing the instruction to the phone when an originator's information cannot be easily identified based upon the display and outputting the voice information that is easily recognizable by the user.

The Muramatsu reference does not remedy the deficiencies of the Henderson reference and the Heie reference.

Indeed, the Examiner does not allege that the Muramatsu reference teaches or suggests these features.

Further, Applicant submits that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different and unrelated matters and problems.

In stark contrast, to the Henderson reference and the Heie reference, the Muramatsu reference is specifically directed to identifying a caller using sound alone without reducing the number of available communication lines ([0011] - [0013]).

One of ordinary skill in the art who was concerned with providing an improved call interrupt feature for a telephone answering device that permits the telephone answering device to reestablish control over the message handling function without depending upon an elapse of time or an off-hook condition, as the Henderson reference is concerned, or who was

concerned with the problem of inputting lengthy character strings, as the Heie reference is concerned, would not have referred to the Muramatsu reference and, vice-versa, because the Muramatsu reference is directed to the completely different and unrelated problem of identifying a caller using sound alone without reducing the number of available communication lines. Thus, these references would not have been combined.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 19-20.

**D. The Brennan reference in view of the Henderson reference and in further view of the Heie reference**

Regarding the rejection of claims 24-26, the Examiner alleges that the Henderson reference would have been combined with the Brennan reference and further alleges that the Heie reference would have been combined with the Henderson reference and the Brennan reference to form the claimed invention. Applicant submits, however, that these references would not have been combined and, even if combined, the combination would not teach or suggest each and every element of the claimed invention.

None of the applied references teaches or suggests the features of independent claim 24 including outputting a voice signal that corresponds to a character string input by a user, let alone outputting a voice signal that corresponds to a character string input by a user if the character string corresponds to the caller and in response to an instruction from the user during an incoming call from the caller.

Indeed, the Examiner fails to present a *prima facie* case for obviousness for failing to allege that any of the applied references teach or suggest these features.

In particular, the Examiner alleges that the Brennan reference discloses outputting a voice signal that corresponds to a character string that corresponds to a caller.

The Examiner does not allege that the Brennan reference discloses outputting a voice signal that corresponds to a character string input by a user, let alone outputting a voice signal that corresponds to a character string input by a user if the character string corresponds to the caller and in response to an instruction from the user during an incoming call from the caller.

The Examiner does not allege that the Henderson reference remedies this deficiency.

The Examiner also does not allege that the Heie reference remedies this deficiency. Rather, the Examiner merely alleges that the Heie reference discloses “a character string input by a user.”

The Examiner does not allege that the Heie reference remedies the deficiencies of the Brennan reference and the Henderson reference because the Examiner does not allege that the Heie reference discloses outputting a voice signal that corresponds to a character string input by a user, let alone outputting a voice signal that corresponds to a character string input by a user if the character string corresponds to the caller and in response to an instruction from the user during an incoming call from the caller.

Rather, the Examiner merely alleges that the Heie reference “teaches a character string input by a user.”

The Examiner does not allege that the Heie reference discloses outputting a voice signal that corresponds to a character string input by a user, let alone outputting a voice signal that corresponds to a character string input by a user if the character string corresponds to the caller and in response to an instruction from the user during an incoming call from the caller.

Therefore, the Examiner fails to present a *prima facie* case for obviousness.

Further, Applicant again submits that these references would not have been combined as alleged by the Examiner. Indeed, the references are directed to completely different and unrelated matters and problems.

One of ordinary skill in the art who was concerned with providing a telephone system that automatically answers a telephone so that someone in a hands-busy situation or a handicapped individual may have calls from pre-selected callers automatically connected, as the Brennan reference is concerned with providing, or who was concerned with the problem of providing an improved call interrupt feature for a telephone answering device that permits the telephone answering device to reestablish control over the message handling function without depending upon an elapsed time or an off-hook condition, as the Henderson reference is concerned with providing, would not have referred to the Heie reference and, vice-versa, because the Heie reference is directed to the completely different and unrelated problem of inputting lengthy character strings. Thus, these references would not have been combined.

Thus, the references would not have been combined.

Further, as explained above, Applicant continues to submit that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner, that the Examiner's alleged modification would destroy the intended purpose of the Brennan reference, and that the Brennan reference teaches away from making the Examiner's alleged modification.

One of ordinary skill in the art at the time the invention was made would not have been motivated to combine these references to form the claimed invention.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 24-26.

**E. The Brennan reference in view of the Henderson reference and in further view of the Heie reference and in yet further view of the Muramatsu reference**

Regarding the rejection of claims 27-28 and 30, the Examiner alleges that the Henderson reference would have been combined with the Brennan reference and further alleges that the Heie reference would have been combined with the Henderson reference and the Brennan reference, and yet further alleges that the Muramatsu reference would have been combined with the Heie reference, the Henderson reference, and the Brennan reference to form the claimed invention. Applicant submits, however, that these references would not have been combined and, even if combined, the combination would not teach or suggest each and every element of the claimed invention.

As explained above, none of the applied references teaches or suggests the features of independent claim 24 including outputting a voice signal that corresponds to a character string input by a user, let alone outputting a voice signal that corresponds to a character string input by a user if the character string corresponds to the caller and in response to an instruction from the user during an incoming call from the caller.

Further, one of ordinary skill in the art who was concerned with providing a telephone system that automatically answers a telephone so that someone in a hands-busy situation or a handicapped individual may have calls from pre-selected callers automatically connected, as the Brennan reference is concerned with providing, who was concerned with the problem of providing an improved call interrupt feature for a telephone answering device that permits the telephone answering device to reestablish control over the message handling function without depending upon an elapsed time or an off-hook condition, as the Henderson reference is



concerned with providing, or who was concerned with the problem of inputting lengthy character strings, as the Heie reference is concerned, would not have referred to the Muramatsu reference, and vice-versa, because the Muramatsu reference is concerned with the completely different and unrelated problem of identifying a caller using sound alone, without reducing the number of available communication lines.

Thus, the references would not have been combined.

Further, as explained above, Applicant submits that the Examiner can point to no motivation or suggestion in the references to urge the combination as alleged by the Examiner.

Therefore, the Examiner is respectfully requested to withdraw the rejection of claims 27-28 and 30.

### **III. FORMAL MATTERS AND CONCLUSION**

In view of the foregoing amendments and remarks, Applicant respectfully submits that claims 1-28 and 30-32, all the claims presently pending in the Application, are patentably distinct over the prior art of record and are in condition for allowance. The Examiner is respectfully requested to pass the above application to issue at the earliest possible time.

Should the Examiner find the Application to be other than in condition for allowance, the Examiner is requested to contact the undersigned at the local telephone number listed below to discuss any other changes deemed necessary in a telephonic or personal interview.


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DOCKET NO. 00-169925

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The Commissioner is hereby authorized to charge any deficiency in fees or to credit any overpayment in fees to Attorney's Deposit Account No. 50-0481.

Respectfully Submitted,

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